

# PATENT COOPERATION TREATY

## PCT

### INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY (Chapter I of the Patent Cooperation Treaty)

(PCT Rule 44bis.)

Applicant's or agent's file reference 13865WO /mt	<b>FOR FURTHER ACTION</b>		See item 4 below
International application No. PCT/EP2004/014311	International filing date ( <i>day/month/year</i> ) 15 December 2004 (15.12.2004)	Priority date ( <i>day/month/year</i> ) 15 December 2003 (15.12.2003)	
International Patent Classification (8th edition unless older edition indicated) See relevant information in Form PCT/ISA/237			
Applicant P.A.L.M. MICROLASER TECHNOLOGIES AG			

1. This international preliminary report on patentability (Chapter I) is issued by the International Bureau on behalf of the International Searching Authority under Rule 44 bis.1(a).
2. This REPORT consists of a total of 6 sheets, including this cover sheet.

In the attached sheets, any reference to the written opinion of the International Searching Authority should be read as a reference to the international preliminary report on patentability (Chapter I) instead.

3. This report contains indications relating to the following items:

- |   |   |
|---|---|
| <input checked="" type="checkbox"/> Box No. I | Basis of the report   |
| <input type="checkbox"/> Box No. II           | Priority  |
| <input type="checkbox"/> Box No. III          | Non-establishment of opinion with regard to novelty, inventive step and industrial applicability  |
| <input type="checkbox"/> Box No. IV           | Lack of unity of invention  |
| <input checked="" type="checkbox"/> Box No. V | Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement |
| <input type="checkbox"/> Box No. VI           | Certain documents cited   |
| <input type="checkbox"/> Box No. VII          | Certain defects in the international application  |
| <input type="checkbox"/> Box No. VIII         | Certain observations on the international application   |

4. The International Bureau will communicate this report to designated Offices in accordance with Rules 44bis.3(c) and 93bis.1 but not, except where the applicant makes an express request under Article 23(2), before the expiration of 30 months from the priority date (Rule 44bis.2).

		Date of issuance of this report 29 August 2006 (29.08.2006)
The International Bureau of WIPO 34, chemin des Colombettes 1211 Geneva 20, Switzerland		Authorized officer
Facsimile No. +41 22 338 82 70	Ellen Moyse e-mail: pt05@wipo.int	

# PATENT COOPERATION TREATY

From the  
INTERNATIONAL SEARCHING AUTHORITY

To:

**TRANSLATION**  
**PCT**

## WRITTEN OPINION OF THE INTERNATIONAL SEARCHING AUTHORITY

(PCT Rule 43bis.1)

		<b>See form PCT/ISA/210</b>
Date of mailing (day/month/year)		
Applicant's or agent's file reference <b>13865WO /mt</b>		
FOR FURTHER ACTION See paragraph 2 below		
International application No. <b>PCT/EP2004/014311</b>	International filing date (day/month/year) <b>15.12.2004</b>	Priority date (day/month/year) <b>15.12.2003</b>
International Patent Classification (IPC) or both national classification and IPC <b>G01N1/28</b>		
Applicant <b>P.A.L.M. MICROLASER TECHNOLOGIES AG</b>		

1. This opinion contains indications relating to the following items:

- Box No. I Basis of the opinion
- Box No. II Priority
- Box No. III Non-establishment of opinion with regard to novelty, inventive step and industrial applicability
- Box No. IV Lack of unity of invention
- Box No. V Reasoned statement under Rule 43bis.1(a)(i) with regard to novelty, inventive step or industrial applicability: citations and explanations supporting such statement
- Box No. VI Certain documents cited
- Box No. VII Certain defects in the international application
- Box No. VIII Certain observations on the international application

2. **FURTHER ACTION**

If a demand for international preliminary examination is made, this opinion will be considered to be a written opinion of the International Preliminary Examining Authority ("IPEA") except that this does not apply where the applicant chooses an Authority other than this one to be the IPEA and the chosen IPEA has notified the International Bureau under Rule 66.1bis(b) that written opinions of this International Searching Authority will not be so considered.

If this opinion is, as provided above, considered to be a written opinion of the IPEA, the applicant is invited to submit to the IPEA a written reply together, where appropriate, with amendments, before the expiration of 3 months from the date of mailing of Form PCT/ISA/220 or before the expiration of 22 months from the priority date, whichever expires later.

For further options, see Form PCT/ISA/220.

3. For further details, see notes to Form PCT/ISA/220.

Name and mailing address of the ISA/EP	Authorized officer
Facsimile No.	Telephone No.

**WRITTEN OPINION OF THE  
INTERNATIONAL SEARCHING AUTHORITY**

International application No.

PCT/EP2004/014311

**Box No. I Basis of this opinion**

1. With regard to the language, this opinion has been established on the basis of the international application in the language in which it was filed, unless otherwise indicated under this item.  
 This opinion has been established on the basis of a translation from the original language into the following language \_\_\_\_\_, which is the language of a translation furnished for the purposes of international search (under Rule 12.3 and 23.1(b)).
2. With regard to any nucleotide and/or amino acid sequence disclosed in the international application and necessary to the claimed invention, this opinion has been established on the basis of:
  - a. type of material
    - a sequence listing
    - table(s) related to the sequence listing
  - b. format of material
    - in written format
    - in computer readable form
  - c. time of filing/furnishing
    - contained in the international application as filed.
    - filed together with the international application in computer readable form.
    - furnished subsequently to this Authority for the purposes of search.
3.  In addition, in the case that more than one version or copy of a sequence listing and/or table(s) relating thereto has been filed or furnished, the required statements that the information in the subsequent or additional copies is identical to that in the application as filed or does not go beyond the application as filed, as appropriate, were furnished.
4. Additional comments:

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INTERNATIONAL SEARCHING AUTHORITY**

International application No.  
**PCT/EP2004/014311**

Box No. V	Reasoned statement under Rule 43bis.1(a)(i) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement
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**1. Statement**

Novelty (N)	Claims <u>6, 9, 29-30</u>	YES
	Claims <u>1-5, 7, 8, 10-28</u>	NO
Inventive step (IS)	Claims <u>6, 9</u>	YES
	Claims <u>1-5, 7, 8, 10-30</u>	NO
Industrial applicability (IA)	Claims <u>1-30</u>	YES
	Claims    _____	NO

**2. Citations and explanations:**

Reference is made to the following documents:

- D1: WO 97/29355 A (P.A.L.M.) 14 August 1997  
(1997-08-14)
- D2: WO 02/10751 (USA GOV.) 7 February 2002  
(2002-02-07)
- D3: AKIYOSHI: "a simplified method ..." JAPANESE JOURNAL OF SURGERY, Vol. 16, No. 3, 1986, pages 235-238, XP008045275 JP
- D4: EP-A-0 743 363 (KABUSHIKI) 20 November 1996  
(1996-11-20)

- 1.1 The present application does not meet the requirements of PCT Article 33(1) because the subject matter of claim 1 is not novel within the meaning of PCT Article 33(2). Document D1 discloses as receiving element an agar-coated carrier (page 16, section 2).
- 1.2 The restriction indicated by the expression "without impairing a suitability of the object for a predetermined processing and/or analysis" is unclear: according to the nature of the object and of the analysis it is established which solvent or reagent could be used in order to detach the adhesive agent, or up to which temperature the adhesive agent could be heated. Agar can be detached by input of heat (D3) or by

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Box No. V Reasoned statement under Rule 43bis.1(a)(i) with regard to novelty, inventive step or industrial applicability:  
citations and explanations supporting such statement

- adding an enzyme (D4). The subject matter of claim 1 is consequently not novel.
- 2 The present application does not meet the requirements of PCT Article 33(1) because the subject matter of claim 29 does not involve an inventive step within the meaning of Article 33(3).
- 2.1 Document D1 is regarded as closest prior art in relation to the subject matter of claim 29. The subject matter of claim 29 therefore differs from the known process in that the adhesive agent of the receiving element is detached.
- 2.2 The problem addressed by the present invention can therefore be considered that of detaching the object from the adhesive agent (description, page 5, lines 5-6).
- 2.3 The solution proposed in claim 29 of the present application cannot be regarded as inventive for the following reasons (PCT Article 33(3)):  
These features (detachment of the adhesive agent from the receiving element in order to extract the cells) have, however, already been used for the same purpose in a similar method, cf. concerning this document D2, especially page 31, lines 1-11. If a person skilled in the art wished to achieve the same aim in a method as per document D1, he could easily apply these features to like effect to the subject matter of D2. In this way he would arrive at a method as per claim 29 without thereby being inventive.
- 3 The same reasoning applies correspondingly to independent claims 7, 8, 27.
- 4 Dependent claims 2-5, 10-26, 30 do not contain any features which, in combination with the features of any

WRITTEN OPINION OF THE  
INTERNATIONAL SEARCHING AUTHORITY

International application No.  
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Box No. V Reasoned statement under Rule 43bis.1(a)(i) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

claim to which they refer back, meet the PCT requirements for novelty and inventive step; see the documents and the appropriate passages indicated in the search report.

- 5 The combination of features present in claims 6 and 9 is neither disclosed in the available prior art, nor is it obvious therefrom:  
no available document discloses an adhesive agent designed to suppress the occurrence of electrostatic forces acting on the object in the receiving element.